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| 09/724,016 | 11/28/2000 | Heinz Focke | FOCKE11 | 7235 |

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EXAMINER

TAWFIK, SAMEH

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3721

DATE MAILED: 06/21/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/724,016

Applicant(s)

FOCKE ET AL. *CM*

Examiner

Sameh H. Tawfik

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-28 is/are pending in the application.
- 4a) Of the above claim(s) 20-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 10-19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2,4&5</u> . | 6) <input type="checkbox"/> Other: . |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 10-19, drawn to a process for producing a dimensionally stable pack made of cardboard, classified in class 493, subclass 156.
- II. Claims 20 and 21, drawn to a process for producing dimensionally stable packs, classified in class 493, subclass 162.
- III. Claims 22-28, drawn to an apparatus for providing an outer wrapper made of thin film, classified in class 493, subclass 278.

The inventions are distinct, each from the other because of the following reasons:

Inventions Groups (I&II) and Group III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process as claimed can be practiced by another materially different apparatus such as one without a folding assembly for providing the outer wrapper in tubular form on the pack nor sacking and sealing stations.

Inventions Group I and Group II are related as combination and subcombination.

Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination

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as claimed because the combination does not require to have the step of inserting a pack in communication with the outer wrapper into a pocket of a folding turret. The subcombination has separate utility such as the step of inserting a pack in communication with the outer wrapper into a pocket of a folding turret.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. Ryan Schneider on 4/4/2002 a provisional election was made without traverse to prosecute the invention of Group I, claims 10-19. Affirmation of this election must be made by applicant in replying to this Office action. Claims 20-28 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Specification

The disclosure is objected to because of the following informalities:

(specification page 4, lines 23 and 25; page 5, line 25) delete "23..26" and insert --23-24-
-; etc.

Appropriate correction is required.

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. For example "process for producing hinge-LID boxes for cigarettes".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 10, 14, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Mattei et al. (4,887,408).

Mattei discloses a process for producing a dimensionally stable pack made of cardboard comprising the steps of providing the pack with an outer wrapper having folding tabs (via flaps 61, 63, 9, and 10), the outer wrapper made of sealable film, see for example (Figs. 1 and 2); folding the tabs into a region of tab overlap (Fig. 2); temporarily maintaining the tabs in the

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region of tab overlap by tacking or by tack connection (claim 1, step (d); via first heat seal means); and fixedly maintaining the tabs in the region of tab overlap by full surface sealing (claim 1, step (f); via second heat seal means); and further folding the at least one set of the folding tabs into a region of tab overlap (Figs. 1 and 3)..

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11-13 and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mattei et al. (4,887,408) in view of McDaniel (4,256,526).

Mattei does not disclose that the maintaining the tabs in the region of tab overlap is by small surface area spot sealing or by linear sealing. However, Daniel discloses that sealing by using small surface area spot sealing or by linear sealing (Fig. 8) and by narrow linear sealing (Fig. 6; via T-shaped adhesive 56 and 57) to apply hot melt adhesive in a pattern in both parallel to and perpendicular to the direction of substrate movement (column 2, lines 52-55).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Mattei's method by having the step of maintaining the tabs in the region of tab overlap is by small surface area spot sealing or by linear sealing, as suggested by Daniel, in order to apply hot melt adhesive in a pattern in both parallel to and perpendicular to the direction of substrate movement.

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Regarding claim 13: Mattei discloses the step of heat treating (via 45 and 57) the outer wrapper (Fig. 2). Mattei does not disclose that the wrapper is a film that shrinks when subjected to heat treatment. However, it would have been obvious to one having ordinary skill in the art to provide a shrink wrapper, as a matter of engineering design choice, since the examiner takes an official notice that such kind of shrinking wrapper is old, well known, and available in the art, see for example (US. Patent 5,899,048; Figs. 3 and 4).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Spada 5766121, Seragnoli 4208854, Seragnoli 4092816, and Schmermund 3924386 disclose different process for producing pack made of cardboard.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sameh H. Tawfik whose telephone number is (703) 308-2809. The examiner can normally be reached on Monday - Friday from 8:00 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rada, Rinaldi can be reached on (703) 308-2187. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3579 for regular communications and (703) 308-7769 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

ST.
June 18, 2002



EUGENE KIM
PRIMARY EXAMINER